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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/795,985	03/10/2004	Douglas Hudson	20420.0002	2264
23517 7590 01/26/2009 BINGHAM MCCUTCHEEN LLP 2020 K Street, N.W. Intellectual Property Department WASHINGTON, DC 20006				
EXAMINER				
NGUYEN, THUY-VI THI				
ART UNIT		PAPER NUMBER		
3689				
MAIL DATE		DELIVERY MODE		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/795,985

Applicant(s)

HUDSON, DOUGLAS

Examiner

THUY VI NGUYEN

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2008.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
4a) Of the above claim(s) 1-8 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 9-15 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 10 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

1. This is in response to the applicant's communication filed on August/18/2008, wherein applicant has elected with traverse Group II, claims 9-15.

Election/Restrictions

2. Applicant's election with traverse of Group II in the reply filed on 10/24/08 is acknowledged. The traversal is on the ground(s) that the claims are related to the same subject matter and the burden of searching an extra subclass is not excessive. This is not found persuasive because this is merely applicant's opinions without specific evidence/analysis of the rejections to indicate why the restriction is not proper. The claims are not related to the same subject matter and have different scopes and have different modes of operations and it is a serious burden for the examiner to search both of these independent inventions which have different claim scopes.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 9-12 are reject under 35 U.S.C. 101 based on Supreme Court precedent, and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such

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as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter. With respect to claim 9, the claim language does not transform the underlying subject matter and the process is not tied to another statutory class. The process steps of “collecting...; assigning...; connecting...; making...” is not tied to another statutory class, such as an apparatus, and thus, the claims are directed to nonstatutory subject matter.

Here claims fail to meet the above requirements since there is not a sufficient tie to another statutory class (2) transformation, and thus is directed to nonstatutory subject matter. Insertion of the use of another statutory class (computer) such as “computer-implemented” or “using a computer” features in the preamble and the critical functions/bodies of the claims would overcome the rejections.

Claims 13-15 are rejected under 35 U.S.C. 101 because the claims deal with a system containing software and do not meet any of the statutory items such as process (method), machine (apparatus), manufacture (product) or composition. The system claims appear to be an apparatus claim in a preamble “a system for providing”, however, there are no structures or functional elements which are required in an apparatus claim. For instant, the independent 13 recited “an administrator system....; a hub...; an interconnection system....”

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appear to be software. Therefore, the claims are directed to nonstatutory subject matter.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 13-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1) Independent claim 9, last step recites " ...any member..." is vague and indefinite because it is not clear this " any member" is the charter member or the member of the service providers.

1) Independent claim 13 calls for system of providing telecommunications in the preamble, however the claim body recites "an administrator system, a hub, and an interconnection system" are vague and indefinite because it is not clear whether this feature includes any structure and functional elements. However, these features can also appear to be software per se. Therefore, the 101 rejection is given as stated above.

2) In dependent claim 13, second step recite " ...a plurality of purchasing members" is vague and indefinite because it's not clear the "purchasing members" are the member of service provider, or they are the customers.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 13-15 are rejected under 35 U.S.C. 102(b) as being anticipated by LUSH (US 2001/0051503).

As for independent claim 13:

Note: that it appears that independent claim 13 is an apparatus claim. In examination of the apparatus claim, the claims must be structurally distinguishable from the prior art. While features of an apparatus claim may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. See MPEP 2114. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). Apparatus claims cover what a device is, not what a device does. *Hewlett-Packard Co. vs. Bausch & Lomb Inc.* (Fed. Circ. 1990). Manner of operating the device or elements of the device, i.e. recitation with respect to the manner in which a claimed apparatus is intended to be employed/used, does not differentiate apparatus from the prior art apparatus. *Ex parte Masham*, 2 USPQ2d 1647 (BPAI, 1987).

Also, this is an apparatus claim and intended use limitation for the system/device or apparatus, i.e. "for selecting...; for connecting.....; for maintaining..." carries no patentable weight.

Therefore, the claim is read as follow:

As for independent claim 13, LUSH discloses a system of providing telecommunications infrastructure to a building, comprising:

- a) an administrator system {see figure 7, par. 0072}
- b) a hub {see figures 7-9 pars. 0097; and pars 0099, 0103, 0121}
- c) an interconnection system {see figure 7, par. 0072-0073, GIS processor 1514}

As for dep. claims 14-15, which deals with the hub and the facilities in the building, this is fairly taught in LUSH, see figures 2B, 7, 9

Note that Note: that it appears that independent claims 13-14 are apparatus claims. In examination of the apparatus claim, the claims must be structurally distinguishable from the prior art. While features of an apparatus claim may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. See MPEP 2114. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). Apparatus claims cover what a device is, not what a device does. *Hewlett-Packard Co. vs. Bausch & Lomb Inc.* (Fed. Circ. 1990). Manner of operating the device or elements of the device, i.e. recitation with respect to the manner in which a claimed apparatus is intended to be employed/used, does not differentiate apparatus from the prior art apparatus. *Ex parte Masham*, 2 USPQ2d 1647 (BPAI, 1987).

Also, this is an apparatus claim and intended use limitation for the system/device or apparatus, i.e. "is maintained by a neutral party for the

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members; and for connecting a purchasing member's customer....path" carries
no patentable weight.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for
all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claims 9-12** are rejected under 35 U.S.C 103 (a) as being unpatentable
over EGAN (US 2004/0076283) in view of MILLER ET AL (US 7,035,809)

As for independent claim 9, EGAN disclose a method of enhancing
telecommunications infrastructure/service comprising:

a) collecting information for a building from a group of telecommunications
service providers, each being a member;

(b) selecting a service provider (owner) to be in charge of the
telecommunications path (infrastructure/easement) among the service providers
(members);

{see par. [0005]}

c) connecting a telecommunications path (infrastructure/easement)
operated by the charter member between a neutral interconnection hub and
potential customers in the building; and

{see par. [0005]-[0006]}

d) making the charter member's path (easement) available for use by any member to service potential customers through interconnection between that member and the neutral hub (infrastructure or easement).

{see par. [0005]-[0006]}

EGAN fairly teaches the claimed invention except for the step of "assigning charter member status to one of the members" in step (b).

In an accelerated Project Improvement framework, MILLER ET AL discloses the assigning charter features to new team members based on selection criteria proposals by the new members so that the company's mission, vision can be communicated effectively to the charter member and other related new members (service providers) to achieve the project {see Figs. 2C, 5C, 5H and 5g, col. 7, lines 28-51, col. 36, lines 5-25}. It would have been obvious to a skilled artisan to modify the teachings of EGAN by modifying the step (b) above so that new team members can understand the company's mission, vision can be communicated effectively to the charter member and other related new members (service providers) to achieve the project as taught by MILLER ET AL.

As for dep. claim 10, which deals with assigning charter member status to one of a plurality of potential charter members based a score, this is fairly taught in MILLER ET AL {see figure 5M. col. 33-55, select the product provider based on the final scores}

As for dep. claims 11-12, which deals with the score determination using application information provided by potential by potential charter members, and essential rights of the charter member this is fairly taught in MILLER ET AL {see figure 5M. col. 33-55, select the product provider based on the final scores}. Note as for this limitation "score is determined using application information and essential right /information" have been determined to be non-functional descriptive material (NFDm), thus having no patentable weight and does not need to be taught by the prior art. Nonfunctional descriptive material can not render nonobvious an invention that would have other wise been obvious. In re Gulack, 703 F. 2d 1381, 1385, 217 USPQ 401, 40-4 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability. See MPEP 2106.01.

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1. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thuy-Vi Nguyen whose telephone number is 571-270-1614. The examiner can normally be reached on Monday through Thursday from 8:30 A.M to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on 571-272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T. N./

Examiner, Art Unit 3689

/Tan Dean D. Nguyen/
Primary Examiner, Art Unit 3689
January 21, 2009